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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,478	11/13/2003	Judy Lynn Westby	STL 8646	2370

27367 7590 04/26/2007  
WESTMAN CHAMPLIN & KELLY, P.A.  
SUITE 1400  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS, MN 55402-3319

EXAMINER
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DU, THUAN N

ART UNIT	PAPER NUMBER
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2116

MAIL DATE	DELIVERY MODE
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04/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.



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**MAILED**

**APR 26 2007**

**CENTRAL REEXAMINATION UNIT**

In re Application of :  
Westby et al. :  
Application No. 10/714,478 : **SECOND ORDER TO**  
Filed: November 13, 2003 : **SHOW CAUSE**  
Attorney Docket No. STL 8646 :

This is in response to the applicants' communication entitled **Response To Order To Show Cause Why The Office Should Not Terminate The Present Reissue Proceeding** filed March 8, 2007, by facsimile transmission, requesting that prosecution of the above-identified application be continued.

Applicants' communication is before the Office of Patent Legal Administration (OPLA) for decision.

**BACKGROUND**

1. The present application ("present reissue proceeding") was filed November 13, 2003, for reissue of U.S. Patent No. 6,317,800 (the '800 patent), which issued November 13, 2001.
2. A review of the Office's financial records for the '800 patent reveals that the 3.5 year maintenance fee due and not paid could have been paid during the period from November 15, 2004 (November 13, 2004 was a Saturday) through May 13, 2005, or with a surcharge during the period from May 16, 2005 (May 14, 2005 was a Saturday) through November 14, 2005 (November 13, 2005 was a Sunday). As a result, the '800 patent expired after midnight on November 13, 2005, for failure to pay the 3.5 year maintenance fee due. See 1302 *Official Gazette* 1232 (January 10, 2006).
3. On November 7, 2006, in the present reissue proceeding, an Order to Show Cause was mailed, but was returned to the Office as undeliverable.
4. On February 1, 2007, in the present reissue proceeding, in response to a telephone communication from Fred A. Silverberg, Senior Legal Advisor in the Office of Patent Legal Administration, a change of address was submitted by facsimile transmission.
5. On February 2, 2007, in the present reissue proceeding, the Order To Show Cause was remailed to the new address. The remailed Order To Show Cause stated that the '800 patent had expired for failure to pay the first maintenance fee, the Director of the Office no longer had the authority under 35 U.S.C. § 251 to reissue the '800 patent, and the

Office intended to terminate the present reissue proceeding and hold the application for reissue of the '800 patent to be an abandoned application. Applicants were given a period of 30 DAYS from the mailing of the remailed Order To Show Cause why the Office should not terminate the present reissue proceeding.

6. In response, on March 8, 2007, in the present reissue proceeding, *inter alia*, the present communication entitled **Response To Order To Show Cause Why The Office Should Not Terminate The Present Reissue Proceeding** and an authorization to charge counsel's deposit account for any deficiency associated with the communication were filed. Applicants request that prosecution of the application be continued as the owner of the '800 patent filed on March 8, 2007, the requisite first maintenance fee along with a petition and petition fee to accept late payment of the maintenance fee based upon the patent owner's unavoidable failure to timely pay the maintenance fee.

37 CFR 1.181(f) states, in part:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

This provision of the rules is a statement that there is no assurance that any petition filed will be granted. Action shall not be taken based upon an assumption of a future grant of a petition. In this instance, the mere filing of the March 8, 2007 petition did not act to restore the '800 patent to status as a live patent. As such, the '800 patent remains in the status of an expired patent for failure to pay the first and second maintenance fees. Accordingly, the Director of the Office does not have the authority under 35 U.S.C. § 251 to reissue the '800 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, **when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director does not have the authority under 35 U.S.C. § 251 to reissue the patent, at present, it remains proper that the Office terminate the present reissue proceeding, and thereafter hold the application for reissue of the '800 patent to be an abandoned application.

In view of the above, applicants' request that the prosecution of the above-identified application be continued is dismissed, and the March 8, 2007 response to the remailed Order To Show Cause of February 2, 2007 is found not to be sufficient to provide basis for examination of the application. The response to the remailed Order To Show Cause of March 8, 2007 is, however, sufficient to the extent that the Office will not terminate the present reissue proceeding at this time. Rather, based on the filing of the March 8, 2007 petition to accept late payment of the maintenance fee, jurisdiction over the reissue proceeding is being retained in the Office of Patent Legal Administration (OPLA), to provide the applicants with an opportunity to provide a second showing of cause as to why the Office should not terminate the present reissue proceeding, as will be discussed in the below conclusion.

### CONCLUSION

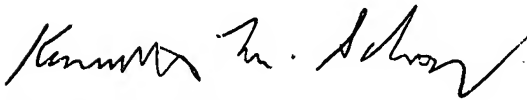
1. Applicants are hereby being provided with a period of **SIX(6) MONTHS** from the mailing of this **SECOND SHOW CAUSE ORDER** to again show cause why the Office should not terminate the present reissue proceeding.
2. If applicants propose to show cause why the present reissue proceeding should not be terminated, **applicants' showing must include** either:

A) A copy of a favorable determination on the merits of the March 8, 2007 petition to accept late payment of the first maintenance fee, or

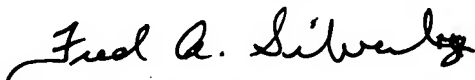
B) An explanation of why the proceeding should not be terminated at that point in time even though the original patent has expired.

Applicants must also show due diligence when providing a response to this Second Order To Show Cause. If applicants make a showing, the showing will be evaluated as to whether due diligence was exercised in providing the showing, and as to whether the showing provides sufficient basis why the present reissue proceeding should not be terminated.

3. **Failure to respond to this Second Order To Show Cause within the SIX (6) MONTH period that has been set in this decision will result in the proceeding being terminated by default.** If the present reissue proceeding is terminated by default, jurisdiction over the application for reissue of the '800 patent would then be returned to Technology Center Art Unit 2116 for processing as an abandoned application.
4. Jurisdiction over the file for reissue application 10/714,478 is being retained in OPLA pending a response by applicants or the expiration of time for a response.
5. Telephone inquiries related to this decision should be directed to Fred Silverberg, Senior Legal Advisor, at (571) 272-7719 or, in his absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner for Patent Examination Policy



Conferee: Fred A. Silverberg, Senior Legal Advisor